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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/057,884	01/29/2002	Nobuya Sato	1080.1104	2407

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STAAS & HALSEY LLP
SUITE 700
1201 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER

GLASS, RUSSELL S

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 03/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/057,884	Applicant(s) SATO, NOBUYA	
	Examiner Russell S. Glass	Art Unit 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/29/2002</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- 1. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors. Examples are as follows:

Claim 1 discloses the limitation "a client operated by an applicant". It is unclear to the examiner in view of the specification how one person is to be operated by another person.

Claim 1 discloses the limitation "a contract section which contracts". It is unclear to the examiner in view of the specification how a contract section is to contract because formation of a contract generally requires the mutual assent of two parties and the wording of claim 1 suggests the formation of a contract by one party.

Claim 3 discloses the limitation "agreement of a content of the insurance". It is unclear to the examiner in view of the specification what "a content of the insurance" is and how it is to confirm agreement.

Claim 4 discloses "an amount of insurance money in the insurance". It is unclear to the examiner whether "an amount of insurance money in the insurance" is referring to premiums paid or coverage totals.

Claim Rejections - 35 USC § 102

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Sherman, (WO 01/59666 A2).

3. An insurance system comprising: a client operated by an applicant who applies for an insurance;

an applicant information storage in which applicant information relating to said applicant is stored prior to the application for the insurance, (Sherman, Fig. 1, #70; p. 4, lines 29-33);

an application receiving section which receives the application for the insurance from said applicant via said client and a communication network, (Sherman, Fig. 1; p. 4, line 29-p. 5, line 4);

an examination section which examines acceptability of the application for the insurance received by said application receiving section based on the applicant information stored in said applicant information storage, (Sherman, p. 4, lines 1-18)

(Underwriting is considered to be equivalent to examining acceptability of the application since it performs an identical function in substantially the same way and produces substantially the same results); and

a contract section which contracts the applied insurance according to a result of the examination by said examination section indicating permission, (Sherman, Fig. 2; p. 4, lines 9-32) (disclosing formation of contract and issuance of policy).

4. The insurance system according to claim 1, further comprising:

a charge storage which stores a charge paid prior to the application for the insurance by said applicant, (Sherman, Fig. 1, #70; p. 4, lines 29-33; p. 11, lines 6-18); and

an accounting section which uses the charge stored in said charge storage to settle a premium of the insurance at a time of the contract of the insurance by said contract section, (Sherman, Fig. 1, #70; p. 4, lines 29-33; p. 11, lines 6-18; col. 12, lines 10-28) (disclosing using the prior underwriting information on first policy to provide a discount when underwriting second policy).

5. The insurance system according to claim 1, further comprising:

a first authentication section which confirms agreement of a content of the insurance contracted by said contract section with a content of the insurance with the application therefor received by said application receiving section, and thereby authenticates validity of the insurance contracted by said contract section, Sherman, p.

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13, line 22-p. 15, line 29) (disclosing underwriting an insurance application by comparing the insurance application with a previously issued insurance contract and associated underwriting information for the purpose of issuing a second contract based partly on the underwriting information related to the first contract).

6. The insurance system according to claim 1, further comprising:

a plurality of said contract sections; and a second authentication section which totals an amount of the insurance money in the insurance to be contracted this time, (Sherman, p. 6, lines 1-23), and

an amount of the insurance money in the insurance already contracted in said plurality of contract sections with respect to the applicant having applied for the insurance at the time of the contract of the insurance by one arbitrary contract section, confirms the total amount within a defined upper limit, and authenticates the validity of the insurance to be contracted this time, (Sherman, p. 6, lines 1-23) (disclosing that the amount primary insurance coverage must be determined and taken into account when underwriting the secondary policy).

7. Claim 5 contains substantially the same or similar limitations as claim 1 and therefore the rejection of claim 1 is incorporated herein by reference.

8. Claim 6 contains substantially the same or similar limitations as claim 2 and therefore the rejection of claim 2 is incorporated herein by reference.

9. Claim 7 contains substantially the same or similar limitations as claim 1 and therefore the rejection of claim 1 is incorporated herein by reference.

10. Claim 8 contains substantially the same or similar limitations as claim 1 and therefore the rejection of claim 1 is incorporated herein by reference.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure is as follows: Sherman, (U.S. Pub. 2001/0034619); Luchs et al., (U.S. 4,831,526); Borghesi et al., (U.S. 5,950,169); Bosco et al., (5,191,522); Peterson et al., (U.S. 6,343,271); DiRienzo et al., (U.S. 6,003,007); Herron et al., (U.S. Pub. 2003/0028404); Wiggins, (U.S. Pub. 2002/0120473); De Grosz et al., (U.S. Pub. 2002/0069090); and Hele et al., (U.S. Pub. 2002/0120474).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Russell S. Glass whose telephone number is 571-272-3132. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 571-272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RSG
3/9/2006

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JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER